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10/765,043	01/28/2004	Tomoko Maruyama	204552031700	9599
7590 Barry E. Bretschneider Morrison & Foerster LLP Suite 300 1650 Tysons Boulevard McLean, VA 22102				
03/18/2008				
EXAMINER				
CHEEMA, UMAR				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/765,043

## Applicant(s)

MARUYAMA ET AL.

## Examiner

UMAR CHEEMA

## Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is response to the Amendment filed on 14 December 2007. Claims 1-15 are pending with claims 1, 11 and 12 being the independent claims and claims 14-15 as being new claims added. Claims 1, 11 and 12 have been amended.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-15** are rejected under 35 U.S.C. 102(b) as being anticipated by Itoh (US 2001/0021037 A1).

**Regarding claim 1**, Itoh teaches a network scanner device for transmitting image data through networks (see abstract, pg. 1, par. 0015-0016) comprising: a reading section for scanning a document to obtain image data (see abstract, pg. 1, par. 0018), a first setting section for setting up a recipient address to which the image data is to be transmitted (pg. 1, par. 0019), a second setting section for setting up a sender address representing a sender by accepting a designation of the sender address which is distinct from an address specifying the network scanner device (see pg. 1, par. 0020, fig. 10- where IP address is the address of the sender instead of the sending location

address; also see par. 0059, 0146; sender and IP address of the transmitting destination), and a transmission control section for carrying out control for adding to the image data the sender address set by the second setting section (see pg. 1, par. 0017, pg. 6, par. 0146, fig. 10, pg. 5, par. 0111) and transmitting the image data to the recipient address set by the first setting section (see pg. 1, par. 0022).

**Regarding claim 2**, Itoh teaches a network scanner device as claimed in claim 1, further comprising a one-touch setting section (see pg. 1, par. 0021) for setting up the recipient address and the sender address simultaneously (see pg. 1, par. 0021, pg. 2, par. 0050).

**Regarding claim 3**, Itoh teaches a network scanner device as claimed in claim 2, wherein the one-touch setting section (see pg. 1, par. 0021) carries out setting of the recipient address and the sender address, in accordance with instructions by the sender (see pg. 2, par. 0050).

**Regarding claim 4**, Itoh teaches a network scanner device as claimed in claim 2, further comprising a display section that is capable of displaying information including the recipient address and the sender address (see fig. 1, pg. 2, par. 0049, pg. 3, par. 0070, pg. 6, par. 0146).

**Regarding claim 5**, Itoh teaches a network scanner device as claimed in claim 1, further comprising a storage section in which candidates of recipient addresses associated with each sender address are stored (see pg. 3, par. 0074), wherein, on setting of the sender address, the recipient address is chosen from candidates of recipient addresses associated with the sender address (see fig. 10, pg. 6, par. 0146).

**Regarding claim 6**, Itoh teaches a network scanner device as claimed in claim 1, further comprising a storage section in which sender addresses associated with IDs representing users are stored (see pg. 2, par. 0054), wherein the sender address is automatically set up in accordance with an inputted ID (see pg. 3, par. 0073).

**Regarding claim 7**, Itoh teaches a network scanner device as claimed in claim 6, further comprising an ID input prompting section for making a display that prompts input of an ID representing a user, as a condition for start of operations of the device (see fig. 1, pg. 2, par. 0049, pg. 3, par. 0073).

**Regarding claim 8**, Itoh teaches a network scanner device as claimed in claim 1, further comprising an operation panel by which information including the recipient address and the sender address is inputted or chosen (see abstract, pg. 1, par. 0019).

**Regarding claim 9**, Itoh teaches a network scanner device as claimed in claim 1, wherein information including the recipient address and the sender address can be inputted through networks (see pg. 1, par. 0055).

**Regarding claim 10**, Itoh teaches a network scanner device as claimed in claim 1, wherein the sending station address specifying the device is included in contents of a text of mail to which the image data is added (see pg. 5, par. 0132).

**Regarding claim 11**, Itoh teaches a network scanner device for transmitting image data through networks (see abstract, pg. 1, par. 0015-0016), comprising: image memory in which image data is stored (see fig. 2, pg. 2, par. 0056), a first setting section for setting up a recipient address to which the image data is to be transmitted (see pg. 1, par. 0019), a second setting section for setting up a sender address representing a sender by accepting a designation of the sender address which is distinct from an address specifying the network scanner device (see pg. 1, par. 0020, pg. 6, par. 0146, fig. 10 -- where IP address is the address of the sender instead of the sending location address; also see par. 0059, 0146; sender and IP address of the transmitting destination), and a transmission control section for carrying out control for adding to the image data the sender address set by the second setting section (see pg. 1, par. 0017, pg. 6, par. 0146, fig. 10, pg. 5, par. 0111) and transmitting the image data to the recipient address set by the first setting section (see pg. 1, par. 0022).

**Regarding claim 12**, Itoh teaches an image data transmitting method of a network scanner device (see abstract, pg. 1, par. 0015-0016) which attaches image data to electronic mail and transmits the image data through networks (see pg. 1, par. 0112-0113), comprising steps of: scanning a document and obtaining the image data (see pg. 1, par. 0002), setting a recipient address to which the image data is to be transmitted (see pg. 1, par. 0019), setting a sender address representing a sender, by accepting a designation of the sender address which is distinct from an address specifying the network scanner device (see pg. 1, par. 0020, pg. 6, par. 0146, fig. 10 -- where IP address is the address of the sender instead of the sending location address; also see par. 0059, 0146; sender and IP address of the transmitting destination), and adding the set sender address to the image data and transmitting the image data to the set recipient address through the networks (see pg. 1, par. 0112-0113, pg. 7, par. 0174, pg. 5, par. 0111).

**Regarding claim 13**, Itoh teaches an image data transmitting method as claimed in Claim 12, wherein the step of scanning a document and obtaining image data (see pg. 1, par. 0015), the step of setting the recipient address to which the image data is to be transmitted (see pg. 1, par. 0019), and the step of setting the sender address representing the sender in place of the sending station address specifying the device are carried out in an altered sequence (see pg. 1, par. 0020, pg. 4, par. 0090, pg. 7, par. 0164).

**Regarding claim 14**, Itoh teaches a network scanner device as claimed in claim 1, wherein the designation of the sender address is carried out by a user selection from addresses stored in the network scanner device in advance (see par. 0059, 0146; sender and IP address of the transmitting destination).

**Regarding claim 15**, Itoh teaches a network scanner device as claimed in claim 1, wherein the designation of the sender address is carried out by an input of the sender address by a user (see par. 0059, 0146, 0106; figure 7, inputs the IP address as the transmitting destination).

### ***Response to Arguments***

3. Applicant's arguments filed on 14 December 2007 have been fully considered but they are not persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address applicant's main point of contention. Applicant's arguments include:

A. Regarding to claims 1, 11 and 12, Applicant argues that these claims have been amended as recited "a second setting section for setting up a sender address representing a sender by accepting a designation of the sender address which is distinct from an address specifying the network scanner device." Itoh does not disclose or suggest such features.

**As for Point A**, it is Examiner's position that Itoh discloses or suggests "a second setting section for setting up a sender address representing a sender by accepting a



designation of the sender address which is distinct from an address specifying the network scanner device (see pg. 1, par. 0020, fig. 10; IP address of sender--where IP address is the address of the sender instead of the sending location address; also see par. 0059, 0146; sender and IP address of the transmitting destination are stored in the IP header, respectively)."

4. **Examiner's Note:** Examiner has cited particular paragraphs, figures, columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to UMAR CHEEMA whose telephone number is (571)270-3037. The examiner can normally be reached on M-F 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Jr. Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

UC

/William C. Vaughn, Jr./

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Supervisory Patent Examiner, Art Unit 2144